

REMARKS

In an Office Action mailed on December 10, 2003, the Examiner maintained the § 103 rejections of claims 45-54. The § 103 rejections are addressed below.

The § 103 rejections of independent claims 45 and 50 are both based on the modification of Nakajima's liquid crystal display device in view of the electric bulletin board display device disclosed in Nishida. In support of the § 103 rejection, the Examiner states that the alleged suggestion or motivation for this combination stems from the need, "to reduce the cost and complexity needed to provide a separate memory at each single pixel while still providing the advantages of the invention of Nakajima." Final Office Action, 6-7. However, contrary to the Examiner's untenable conclusion, the Examiner provides no support as to why modifying Nakajima's display device so that each memory is associated with several pixels would reduce the cost and complexity of Nakajima's device. More specifically, the Examiner states a mere conclusion, without citing any language to support this position. In fact, modification of Nakajima's display device, as contended by the Examiner, would arguably result in more cost and complexity in Nakajima's device, as the memory 22 of the pixel cell in Nakajima would now serve more than one pixel. Thus, arguably additional circuitry, complexity and cost would be added to Nakajima's display device by the modification.

The Examiner cites language from Nakajima to allegedly show the suggestion or motivation for the modification of Nakajima. However, this language merely states that various variations may be made. However, this language is general in nature, and none of this language provides a teaching or suggestion to modify Nakajima's display device so that the memory of each pixel is used by more than one pixel cell. Likewise, the language cited from Nishida merely discusses each display unit has a single memory. However, this language provides no suggestion or motivation for one skilled in the art, without knowledge of the claimed invention, to modify Nakajima's device so that the pixel cell of Nakajima has multiple pixel cells for each memory 22.

"Obviousness cannot be predicated on what is unknown." Thus, the Examiner must provide citations to a prior art reference establishing the alleged suggestion or motivation to combine and/or modify references to derive the claimed invention. *See Ex parte Gambogi*, 62 USPQ2d 1209, 1212 (Bd. Pat. App. & Int. 2001); *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); M.P.E.P. § 2143. In the Final Office Action, the Examiner cites *In re Fine*,

5 USPQ2d 1596 (Fed. Cir. 1988). However, contrary to the Examiner's position, *In re Fine* further supports the Applicant's position that a *prima facie* case of obviousness has not been established for either independent claim 1, 45 or 50.

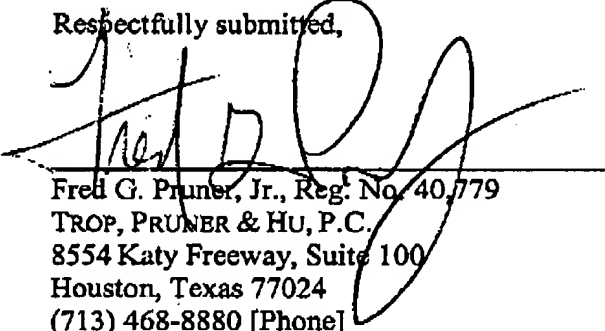
More specifically, in *In re Fine*, the Federal Circuit held that the Examiner had failed to establish a *prima facie* case of obviousness because of the Examiner's bald assertion that a substitution "would have been within the skill of the art," without offering any support for or explanation of this conclusion. *In re Fine*, 5 USPQ2d at 1599. The Federal Circuit agreed with the appellant that a *prima facie* case of obviousness had not been established and stated, "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *Id.*, 1600. See also, *W.L. Gore & Associates, Inc v. Garlock, Inc.*, 220 USPQ 303, 312-13 (Fed. Cir. 1983 ) (stating, "to imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against his teacher"); *Al-Site Corp. v. VSI Int'l, Inc.*, 50 USPQ2d 1161, 1171 (Fed. Cir. 1999) (stating, "rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment").

Thus, the Examiner must show that one skilled in the art, *without knowledge of the claimed invention*, would have modified Nakajima in view of Nishida to derive the claimed invention. Because the Examiner has failed to make this showing, a *prima facie* case of obviousness has not been established for either claim 45 or claim 50. Claims 46-49, 51 and 52 are patentable for at least the reason that these claims depend from allowable, independent claims. Thus, withdrawal of the § 103 rejections of claims 45-52 is requested.

CONCLUSION

In view of the foregoing, withdrawal of the § 103 rejections and a favorable action in the form of a Notice of Allowance are requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (ITL.0312US).

Respectfully submitted,

Date: February 10, 2004

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